

## R E M A R K S

Claims 1 - 34 and 70-72 are pending in the present application.  
Claims 1, 70-72 are independent.

## RCE

A Request for Continued Examination is filed herewith to obtain consideration of the following remarks.

## Section 103(a) Rejections

Claims 1 - 34 and 70 - 72 are rejected as being unpatentable over a combination of Johnsen (U.S. Patent No. 5,250,789), Gottlich (U.S. Patent No. 6,024,288) and the Folio publication. Applicants respectfully traverse the Examiner's Section 103(a) rejection. Claims 5 - 9 are alternatively rejected under a combination of Johnsen, Gottlich, Folio and Flaten (U.S. Patent No. 5,467,269).

Limitations Not Taught

Independent claims 1, 70, 71 and 72 each recite:

*outputting an offer for a rebate in exchange for establishing a subscription to a periodical, in which the subscription to the periodical is not the at least one item*

No references of record, either alone or in combination, disclose or suggest this feature.

For example, no references disclose or suggest outputting an offer for anything in exchange for anything else.

Further, no references disclose or suggest outputting an offer for anything in exchange for establishing a subscription to a periodical.

Finally, no references disclose or suggest outputting an offer for a rebate in exchange for establishing a subscription to a periodical.

In addition, independent claims 1, 70, 71 and 72 each recite that:

*generating a code if the at least one item is associated with an offer for a rebate*

No references of record, either alone or in combination, disclose or suggest this feature. Flaten does not disclose or suggest that codes are generated if an item is associated with an offer for a rebate. Johnsen likewise does not disclose or suggest that codes are used at all.

Contents of the References

The rejection relies on three references of record: Johnsen, Gottlich, Folio and Flaten.

Johnsen discloses a system mounted on a shopping cart, where a shopper may retrieve a manufacturer rebate for a product he scans:

*"Manufacturers that are making rebates available can simply have them electronically stored in the store's central computer. Thus, when a shopper selects and scans the product, the display system can indicate on the display a screen that a rebate is available.*

*If the shopper wishes to participate in the rebate, they can press the appropriate button on the display screen and have that rebate form printed out on the printer 32." Johnsen, Col. 9, lines 25 - 33.*

Note that, contrary to the Examiner's assertion, nowhere in Johnsen or any other reference of record is there a teaching of anything being done "at a POS".

Folio discloses the sale of 'retail gift certificates':

*"People Weekly's consumer marketing director, Jerry Koch, reports his program of retail gift certificates met with 'modest success.' Launched last fall, People's 10-issue gift sub packs are a twist on its earlier frequent-buyer program, which offers similar 10-packs of certificates at subscription prices that are redeemable at newsstands." (second paragraph of Folio)*

Folio also discloses the distribution to retail stores of prepaid subscription order forms and gift cards:

*"Subscriber Systems puts prepaid subscription-order forms and gift cards into packages it distributes to retail stores. ... Subscription Systems works as an agent, underwriting all costs and then forwarding orders to the publishers after taking a percentage." (third paragraph of Folio)*

There is no indication that either of these Folio programs are any more successful at signing up subscribers than, e.g., the presence of subscription cards in periodicals that are sold at retail stores.

Note that, contrary to the Examiner's assertion, nowhere in Folio or any other reference of record is there a teaching of "an offer for a magazine subscription" at a retail store. No offers of any sort are mentioned in Folio.

Gottlich discloses issuing a coupon for an item related to an item being purchased:

*"placing coupons on or in a product for use on the consumer's next purchase of that or a related product or issuing a coupon at the checkout for a related item based on an item currently being purchased. For example, if the consumer purchases dog food, the register might kick out a coupon for dog shampoo." Gottlich, Col. 1, lines 66 - Col. 2, line 5*

Flaten discloses that coupons may include printed codes:

*"The preliminary message may require the user to enter a code at 36. It is contemplated by the present invention that the code will be a predetermined, unique code placed on a coupon or rebate certificate in order for the consumer or the user to enter into the redemption procedure of this invention and to continue this procedure and ultimately obtain his or her rebate. In addition, multiple codes can be listed as a part of the certificate or coupon so as to designate a product code, store code, manufacturer code, retailer code, etc, thereby to supply valuable marketing and routing information to the administrators of the system"*

#### No Substantial Evidence of Asserted Limitations

However, beyond the teachings of the references of record, there is no evidence to support several other assertions that the Section 103 rejection relies upon. Specifically, there is no substantial evidence to support the various assertions of what is "well known" in the art.

There is similarly no substantial evidence to support the proposed motivations to combine and modify the references.

Accordingly, the Examiner has failed to make a prima facie case of obviousness of any pending claim.

If there is such evidence in the record which Applicants have not been able to locate, Applicants respectfully request that the Examiner indicate such evidence with specificity.

The following are unsupported assertions of the scope of the prior art.

**Page 3 of the Office Action:**

"The printed rebate form would inherently include information about the rebate, including rebate identification so that it could be properly processed, as is well known. Such printed coding reads on the code of applicant's claims. Johnsen teaches printing such 'code(s)', which inherently includes outputting a signal representing the code"

There is no correspondence between what Johnsen teaches may be printed, and a code as claimed and described in the present application.

"The printed rebate form is inherently a machine readable message (specific to the item), however, it would have been obvious to one of ordinary skill at the time of the invention to have provided the necessary info such as valid dates, productID, product description etc as is known with rebates as bar-coded data so as to more efficiently enable processing"

There is no disclosure that rebate forms are "inherently a machine readable message (specific to the item)".

**Page 4 of the Office Action:**

"Claim 23 is met by the database search for a valid rebate (offer rebate if matching item found)."

There is no correspondence between what Johnsen teaches may be printed, and a rule as claimed and described in the present application.

No Motivation to Combine or Modify the References

Various modifications to the references and combinations of the references are proposed by the Examiner. However, none of these motivations are suggested by the prior art, by the knowledge of one of ordinary skill in the art, or by the nature of the problem to be solved. The examiner has not supported these proposed motivations with any evidence in the record. In fact, in each case the only the Applicants' disclosure could provide the desirability of the modification or combination.

The following are unsupported motivations proposed by the Examiner.

**Page 2 of the Office Action:**

*"It would have been obvious to have offered and created any type of savings incentive, including a rebate for Folio 2/1/92's subscription purchase when a related 'item' is scanned at the point of sale. This would enable subscription incentives to be offered and targeted to purchases of related products as well as provide incentives for consumers to purchase subscriptions that are not particularly selling well."*

(Note that there is no motivation to combine Gottlich (offering a coupon for an item related to an item being purchased) with Folio (selling certificates for subscriptions). The stated motivation "*to enable subscription incentives to be offered and targeted to purchases of related products as well as provide incentives for consumers to purchase subscriptions that are not particularly selling well*" is not suggested by any references. Only the Applicants' disclosure suggests the desirability of offering subscriptions.)

(Note also that, even if such a combination was properly made, there is no teaching or suggestion of exactly what a 'related' product could be to trigger such an offer for a subscription to a periodical.)

**Page 3 of the Office Action:**

"It would have been obvious to one of ordinary skill at the time of the invention to have stored the necessary rebate information in the POS accessible database so that a customer could be informed of the corresponding subscription rebate when the related item is scanned."

"It would have been obvious to one of ordinary skill at the time of the invention to have created an authentication code associated with the particular rebate printout so as to discourage/prevent unauthorized rebate use/abuse."

"It would have been obvious to one of ordinary skill at the time of the invention to have generated such a code randomly or via encryption of known values related to the rebate so that the numbering scheme that validates the rebate cannot be easily guessed or predicted, thus preventing counterfeiting."

"It would have been obvious to one of ordinary skill at the time of the invention that the printing/coding of the rebate offer would include valid dates, productID, product description as well as contact info such as rebate provider, telephone help line, address, phone number, etc as is known with rebates."

"The printed rebate form is inherently a machine readable message (specific to the item), however, it would have been obvious to one of ordinary skill at the time of the invention to have provided the necessary info such as valid dates, productID, product description etc as is known with rebates as bar-coded data so as to more efficiently enable processing"

**Page 4 of the Office Action:**

"[I]t would have been obvious to one of ordinary skill at the time of the invention to have bundled the subscription package with the current issue o [sic] the magazine to encourage impulse purchases for those who pick up and leaf through the current issue."

"Regarding claim [sic] 33 and 34, it would have been obvious to one of ordinary skill at the time of the invention to have provided text describing the magazine offer and / or numeric dates and/or numeric pricing with the printing/coding on the rebate form printout."

**Conclusion**

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

**Petition for Extension of Time to Respond**

Applicants hereby petition for a **three-month** extension of time with which to respond to the Office Action. Please charge \$460.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



Michael M. Downs  
Attorney for Applicants  
Registration No. 50,252  
Mdowns@walkerdigital.com  
Walker Digital, LLC  
203.461.7292 / voice  
203-461-7300 / fax

November 27, 2002  
Date